

## REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1-4, 8-10 and 12-13 are rejected under 35 U.S.C. 103(a) over the patent to Yi in view of the patent to Kirby.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) over the patent to Yi in view of the patent to Kirby and further in view of the patent to Menon.

The Examiner also indicated that claims 14-16 had to be withdrawn from considerations and corresponding identifiers should be provided.

In connection with the formal issues raised by the Examiner, claims 14-16 have been identified as withdrawn from consideration.

After carefully considering the Examiner's grounds for the rejection of the claims over the art, applicant amended claim 1, the broadest claim on file, so as to more clearly define the present invention and to distinguish it from the prior art.

Turning now to the Examiner's rejection of the claims over the art and in particular the rejection of the claims as being unpatentable over the patent to Yi in view of the patent to Kirby, in the Examiner's opinion the patent to Kirby disclosed a fuel cell stack, comprising an anode layer and a cathode layer, comprising different catalytic compositions. Therefore, in the Examiner's opinion two fuel cell elements with different catalytic coatings are known.

This conclusion however is not correct. A fuel cell stack includes a plurality of individual fuel cell elements. They include correspondingly an anode layer and a cathode layer. The patent to Kirby discloses that the anode layers and the cathode layers have different catalytic compositions. He justifies this by different reactions which take place on the anode layer and on the cathode layer. At the same time, all cathode layers have the same catalytic compositions and all anode layers have the same catalytic compositions. In other words, the patent to Kirby discloses a series circuit with fuel cell elements provided with identical catalytic coatings, wherein all catalytic coatings of the anode area are identical and all catalytic coatings of the cathode area are identical.

In a fuel cell device in accordance with the present invention as defined in claim 1, in contrast to the device disclosed in the Kirby reference, individual fuel cell elements have different catalytic coatings. In

other words, not only these fuel cell elements have different catalytic coatings on the cathode side and anode side, but also different fuel cell elements have different catalytic coatings on their cathode side or different catalytic coatings on their anode side.

Claim 1 has been amended to more clearly define this feature of the present invention. This feature of the present invention is not disclosed in the patent to Kirby. It is also not disclosed in the patent to Yi.

As for the Examiner's rejection of the claims under 35 U.S.C. 103(a) over the combination of these references, it is believed to be clear that none of the references teaches the above mentioned new features of the present invention as defined in the amended claim 1, and any combination of the references, including the combination proposed by the Examiner, would not lead to the applicant's invention, since a hypothetical fuel cell device produced from such a combination would be different from the fuel cell device of the present invention.

In order to arrive at the applicant's invention from the combination of the references, the references had to be fundamentally modified. However, it is known that in order to arrive at a claimed

invention, by modifying the references the cited art must itself contain a suggestion for such modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals, which for example, held in its decision in *re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

The same is true with respect to the combination of the patents to Yi, Kirby and Menon. The patent to Menon also does not teach the new features of the present invention as defined in the amended claim 1, and therefore the combination of these three references would not lead to the applicant's invention as defined in claim 1.

Claim 1 should be considered as patentably distinguishing over the art and should be allowed.

As for the dependent claims, these claims depend on claim 1, they share its presumably allowable features, and therefore it is respectfully submitted that they should be allowed as well.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance; he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

**/ Michael J. Striker /**

Michael J. Striker  
Attorney for Applicant  
Reg. No. 27233